

REMARKS

By this Amendment, Applicant cancels claims 1-7 without prejudice or disclaimer of the subject matter thereof, and amends claims 8-14 and 16 for clarity and to provide antecedent support for all of the recitations. Claims 8-17 are now pending in this application.

In the Office Action mailed March 10, 2004, the Examiner objected to the disclosure at page 3, lines 1-7, because the sentence was not grammatical. Applicant has amended the sentence for further clarity and respectfully requests the Examiner to withdraw the objection.

The Examiner alleged the title of the invention was not descriptive and required a new title. Applicant has amended the title to "PORTABLE ELECTRONIC DEVICE WITH A SECURITY FUNCTION AND A NONVOLATILE MEMORY." Applicant respectfully requests that the Examiner acknowledge acceptance of the amended title in the next Office communication.

The Examiner objected to claims 8 and 9 due to informalities. Applicant has amended claims 8 and 9 for clarity and respectfully requests the Examiner to withdraw the objection.

The Examiner rejected claims 8 and 9 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Applicant has amended claims 8 and 9 for further clarity and respectfully submits that the steps referred to the Examiner recited in claims 8 and 9 are enabled by, for example, the description at page 11, lines 10-22 of the specification. Accordingly, Applicant respectfully requests the Examiner to withdraw the rejection of claims 8 and 9 under 35 U.S.C. § 112, first paragraph.

The Examiner rejected claims 5, 6, 11, 12, 14, and 16 under 35 U.S.C. § 112, second paragraph, as being indefinite. Because Applicant has canceled claims 5 and 6, without prejudice or disclaimer, the rejection of these claims is moot. Regarding claims 11, 12, 14, and 16, Applicants have amended these claims to include proper antecedent support for the phrases cited by the Examiner. Accordingly, the Examiner should withdraw the rejection of claims 11, 12, 14, and 16.

The Examiner rejected claims 1 and 4 under 35 U.S.C. § 112, second paragraph, as incomplete for omitting essential steps. Because Applicant has canceled claims 1 and 4, without prejudice or disclaimer, the rejection of these claims under 35 U.S.C. § 112, second paragraph, is moot.

The Examiner rejected claims 1-2, 4-5, 7-11, and 13 under 35 U.S.C. § 102(b) as anticipated by Iijima (U.S. Patent No. 5,365,045); rejected claims 12 and 14 under 35 U.S.C. § 103(a) as unpatentable over Iijima in view of Schneier, Applied Cryptography, 2nd Edition; and rejected claims 3, 6, and 15-17 under 35 U.S.C. § 103(a) as unpatentable over Iijima in view of Schneier, and in further view of Grimonprez et al. (U.S. Patent No. 5,473,690).

Applicant respectfully traverses the rejection of claims 1-2, 4-5, 7-11, and 13 under 35 U.S.C. § 102(b) as anticipated by Iijima. Because Applicant has canceled claims 1-2, 4-5, and 7, without prejudice or disclaimer, the rejection of these claims is moot.

To properly anticipate Applicants' claimed invention under 35 U.S.C. § 102(b), the Examiner must demonstrate the presence of each and every element of the claim in issue, either expressly described or under principles of inherency, in a single prior art

reference. Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” See M.P.E.P. § 2121 (8th ed., Aug. 2001), *quoting* Richardson v. Suzuki Motor Co., 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Finally, “[t]he elements must be arranged as required by the claim.” M.P.E.P. § 2131 (8th ed. 2001), p. 2100-69.

Applicant’s claim 8 recites a portable electronic device with a security function, containing an application program comprising, among other things, “means for storing validity data indicating whether the security function is valid in a nonvolatile memory, wherein the validity data is received as a command message from outside of the device” and “first means for writing or rewriting data in the nonvolatile memory after receiving the command message when the first determining means determines that the command message does not include the validity data for the security function and the second determining means determines the validity data is not stored in the nonvolatile memory.” Iijima does not disclose at least these features.

By contrast, Iijima discloses that assignment flag 34 is turned off in an initial state and is turned on when one DF is defined. See col. 5, lines 54-57. However, this teaching does not disclose or suggest at least “means for storing validity data indicating whether the security function is valid in a nonvolatile memory, wherein the validity data is received as a command message from outside of the device,” as alleged by the Examiner. Accordingly, the Examiner should withdraw the rejection of claim 8 for at least this reason.

In addition, Iijima discloses generating leading address information by calculating a sum of the value in leading address storage 32 and an address value corresponding

to file size information in the input command data. See col. 6, lines 36-40. However, this teaching does not disclose or suggest at least “first means for writing or rewriting data in the nonvolatile memory after receiving the command message when the first determining means determines that the command message does not include the validity data for the security function and the second determining means determines the validity data is not stored in the nonvolatile memory,” as alleged by the Examiner. Accordingly, the Examiner should withdraw the rejection of claim 8 for at least this additional reason.

Dependent claims 9-11 and 13 depend from allowable independent claim 8. For at least the same reasons discussed above, dependent claims 9-11 and 13 are also allowable. Accordingly, Applicant requests the Examiner to withdraw the rejection of claims 9-11 and 13.

Applicant respectfully traverses the rejection of claims 12 and 14 under 35 U.S.C. § 103(a) as unpatentable over Iijima in view of Schneier. To establish a proper *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must demonstrate each of three requirements. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. See M.P.E.P. § 2143.01 (8th ed. 2001). Third, a reasonable expectation of success must exist. See M.P.E.P. § 2143.02 (8th ed. 2001). Moreover, each of these requirements must be found in the prior art, not in applicant’s disclosure. See M.P.E.P. § 2143 (8th ed. 2001).

Claims 12 and 14 depend indirectly from allowable claim 8. Regarding Iijima, the Examiner admits it does not “disclose additional spare data on the command message guaranteeing the justifiability of the data” (Office Action, page 8). The Examiner then alleges Schneier makes up for the deficiencies of Iijima. Applicant respectfully disagrees. Schneier discloses protocols for cryptography, however, it does not disclose or suggest the features recited in claims 12 and 14.

In addition, the Examiner alleges motivation to combine Iijima and Schneier is found because it would enable justification of command data by the IC card as taught by Scheier using standard means. Applicant respectfully disagrees and notes that the required motivation to combine references must “be found in the prior art, and not based on applicant's disclosure.” See M.P.E.P. § 2143. There is no suggestion or motivation arising from Iijima and Schneier that would lead one of ordinary skill in the art to combine their teachings. Instead, the Examiner appears to be relying upon recitations of Applicant's claims, which is impermissible.

In addition, regarding the Examiner's conclusion of the existence of a motivation by “using standard means” indicated at the top of page 9, Applicant respectfully traverses the Examiner's presumed taking of Official Notice.

Applicant refers the Examiner to the February 21, 2002 Memorandum from USPTO Deputy Commissioner for Patent Examination Policy, Stephen G. Kunin, regarding “Procedures for Relying on Facts Which are Not of Record as Common Knowledge or for Taking Official Notice.” In relevant part, the Memorandum states, “If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual

statements and explanation to support the finding” (Memorandum, p. 3). Applicants submit that the Examiner has made a generalized statement regarding Applicants’ claims 29, 32, 38, and 41 without any documentary evidence to support it. Applicants traverse the Examiner’s presumed taking of “Official Notice,” noting the impropriety of this action, as the Federal Circuit has “criticized the USPTO’s reliance on ‘basic knowledge’ or ‘common sense’ to support an obviousness rejection, where there was no evidentiary support in the record for such a finding.” *Id.* at 1. Applicants submit that “[d]eficiencies of the cited references cannot be remedied by ... general conclusions about what is “ basic knowledge” or “common sense.”” *In re Lee*, 61 USPQ2d 1430, 1432-1433 (Fed. Cir. 2002), quoting *In re Zurko*, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001).

Should the Examiner maintain the rejection after considering the arguments presented herein, Applicants submit that the Examiner must provide “the explicit basis on which the examiner regards the matter as subject to official notice and allow Applicants to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made” (*Id.* at 3, emphasis in original), or else withdraw the rejection. For at least these reasons, the Examiner should withdraw the rejection of claims 12 and 14.

Applicant respectfully traverses the rejection of claims 3, 6, and 15-17 under 35 U.S.C. § 103(a) as unpatentable over Iijima in view of Schneier, and in further view of Grimonprez. Because Applicant has canceled claims 3 and 6 without prejudice, the rejection of these claims is moot.

Claims 15-17 depend indirectly from allowable claim 8. As discussed above, Iijima and Schneier do not disclose or suggest each and every element of claim 8. Grimonprez, which discloses loading a plurality of applications into a memory card, does not make up for the deficiencies of Iijima and Schneier. In addition, Applicant respectfully notes that the Examiner has not demonstrated a motivation for combining the teachings of Grimonprez with that of Iijima and Schneier. Instead, the Examiner appears to again rely upon recitations of Applicant's claims in making an allegation of motivation to combine. In addition, the Examiner also alleges motivation would "enable the card to securely provide a plurality of applications wherein the password to access one application would be independent of the passwords to access the others" (Office Action, pages 9-10). Applicant respectfully submits that the Examiner has not shown that such a motivation is suggested by the prior art. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." M.P.E.P. § 2143.01, p. 2100-124, *citing In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Nor has the Examiner shown a reasonable expectation of success. For at least these reasons, the Examiner should withdraw the rejection of claims 15-17.

In making the various references to the specification above, it is to be understood that Applicant is in no way intending to limit the scope of the claims to the exemplary embodiments shown in the drawings and described in the specification. Rather, Applicant expressly affirms that he is entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation and applicable case law.

CONCLUSION

In view of the foregoing remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: June 10, 2004

By: Anthony Zili Reg. No. 53,232
for Richard V. Burgujian
Reg. No. 31,744